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OFFICE OF PETITIONS

In re Application of :
Rabih Moughelbay et al. :
Application No. 10/516,471 : DECISION ON RENEWED PETITION
Filed: November 29, 2004 : UNDER 37 C.F.R. § 1.137(A)
Attorney Docket No. 37388- :
404200 :
Title: TYING DEVICE :
:

This is a decision on the renewed petition filed October 2, 2007, pursuant to 37 C.F.R. § 1.137(a)¹, to revive the above-identified application.

BACKGROUND

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action, mailed February 15, 2006, which set a shortened statutory period for

¹ A grantable petition pursuant to 37 C.F.R. § 1.137(a) must be accompanied by:

- (1) the required reply (in a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application; in an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof);
- (2) the petition fee;
- (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable, and;
- (4) a terminal disclaimer (and fee as set forth in §1.20(d)) required pursuant to paragraph (d) of this section.

reply of three months. A response was received on August 15, 2006 (along with a "preliminary amendment") however it does not appear that an extension of time under the provisions of 37 C.F.R. § 1.136(a) was requested. Accordingly, the above-identified application became abandoned on May 16, 2006. A notice of abandonment was mailed on September 18, 2006.

PROCEDURAL HISTORY

An original petition pursuant to 37 C.F.R. § 1.137(a) was filed on September 17, 2007, and was dismissed via the mailing of a decision on September 28, 2007, for failure to execute the petition.

THE APPLICABLE STANDARD

Nonawareness of a PTO rule will not constitute unavoidable delay²

The burden of showing the cause of the delay is on the person seeking to revive the application³.

"[T]he question of whether an applicant's delay in prosecuting an application was unavoidable must be decided on a case-by-case basis, taking all of the facts and circumstances into account."⁴

The general question asked by the Office is: "Did petitioner act as a reasonable and prudent person in relation to his most important business?"⁵

A delay caused by an applicant's lack of knowledge or improper application of the patent statute, rules of practice, or the MPEP is not rendered "unavoidable" due to either the applicant's reliance upon oral advice from USPTO employees or the USPTO's failure to advise the applicant to take corrective action.⁶

² See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (Fed. Cir. 1982) (citing Potter v. Dann, 201 U.S.P.Q. (BNA) 574 (D.D.C. 1978) for the proposition that counsel's nonawareness of PTO rules does not constitute "unavoidable" delay)). Although court decisions have only addressed the issue of lack of knowledge of an attorney, there is no reason to expect a different result due to lack of knowledge on the part of a pro se (one who prosecutes on his own) applicant. It would be inequitable for a court to determine that a client who spends his hard earned money on an attorney who happens not to know a specific rule should be held to a higher standard than a pro se applicant who makes (or is forced to make) the decision to file the application without the assistance of counsel. See also Donnelley v. Dickinson, 123 Fsupp2d 456, 459.

³ Id.

⁴ See In re Sivertz, 227 USPQ 255, 256 (Comm'r Pat. 1985).

⁵ See In re Mattulah, 38 App. D.C. 497 (D.C. Cir. 1912).

⁶ See In re Sivertz, 227 USPQ 255, 256 (Comm'r Pat. 1985).

Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present⁷.

A petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable".⁸

In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account".⁹

A petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable".¹⁰

ANALYSIS

The decision on the original petition set forth, in pertinent part:

It is noted that a review of the electronic file indicates that the present petition was submitted via facsimile transmission, and it appears that only the first page of form PTO/SB/61 (a form that consists of three pages plus a one-page privacy statement) was received.

With this renewed petition, Petitioner has asserted that the previous submission consisted of the entire petition, and has provided a copy of the same. It is noted that the petition contains a certificate of facsimile transmission dated September 17, 2007. It is further noted that \$1540 was charged to

⁷ In re Mattullath, 38 App. D.C. at (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913).

⁸ Haines, 673 F. Supp. at 314, 316-17; 5 USPQ2d at 1131-32.

⁹ Smith v. Mossinghoff, 671 F.2d at 538; 213 USPQ at 982.

¹⁰ Haines, 673 F. Supp. at 314, 316-17; 5 USPQ2d at 1131-32.

Petitioner's Deposit Account, when only \$500¹¹ was due. The difference has been refunded to Petitioner's Deposit Account.

With this renewed petition, Petitioner has met requirements (1)¹² and (2) of 37 C.F.R. § 1.137(a). The fourth requirement is not applicable.

Petitioner has asserted that the entire period of delay was unavoidable, and that an "adequate showing of the cause of the delay" was enclosed with this renewed petition. However, the electronic file has been reviewed, and a statement of facts explaining the cause of the delay has not been located. As such, Petitioner has failed to establish that the entire period of delay was unavoidable.

It follows that the present petition must be DISMISSED.

CONCLUSION

Any reply must be submitted within TWO MONTHS from the mail date of this decision. Extensions of time under 37 C.F.R. § 1.136(a) are permitted. The reply should include a cover letter entitled "Renewed Petition Under 37 C.F.R. § 1.137(a)." This is not a final agency action within the meaning of 5 U.S.C § 704.

The renewed petition should indicate in a prominent manner that the attorney handling this matter is Paul Shanoski, and may be submitted by mail¹³, hand-delivery¹⁴, or facsimile¹⁵. Registered users of EFS-Web may alternatively submit a response to this decision via EFS-Web¹⁶.

If responding by mail, Petitioner is advised not to place the undersigned's name on the envelope. Only the information that appears in the footnote should be included - adding anything else to the address will delay the delivery of the response to the undersigned.

11 Although the fee that is associated with the filing of a petition to revive under the unavoidable standard is presently \$510, the fee that was in effect on September 17, 2007 was \$500.

12 A copy of the amendment that was submitted with the original petition was included with this renewed petition.

13 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

14 Customer Window, Randolph Building, 401 Dulaney Street, Alexandria, VA, 22314.

15 (571) 273-8300- please note this is a central facsimile number.

16 <https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>

Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3225¹⁷. All other inquiries concerning examination procedures or status of the application should be directed to the Technology Center.



Paul Shanoski
Senior Attorney
Office of Petitions
United States Patent and Trademark Office

¹⁷ Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for any further action(s) of Petitioner.